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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/511,127 | 10/13/2004 | Richard Hugh Clark | TS7609US | 9323 |

7590 05/13/2009
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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
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1797

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| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

05/13/2009

PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/511,127
Filing Date: October 13, 2004
Appellant(s): CLARK ET AL.

Yukiko Iwata
For Appellant

EXAMINER'S ANSWER

This is in response to the Appeal Brief filed 09 December 2008 and the Amended Appeal Brief filed 16 February 2009 in response to the Notification of Non-Compliant Appeal Brief mailed 26 January 2009 appealing from the Office action mailed 03 June 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

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(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellants' statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

A substantially correct copy of appealed claims 1-8 appears on page s 6 and 7 of the Appendix to the appellants' brief. The minor errors are as follows:

The method of claim 6 depends from claim 1, and NOT from claims 1-5 as indicated.

(8) Evidence Relied Upon

| | | |
|-----------|-----------------|---------|
| 7,189,269 | CLARK et al | 3-2007 |
| 6,056,793 | SUPPES | 5-2000 |
| 6,663,767 | BERLOWITZ et al | 12-2003 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 stands rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 20 of U.S. Patent No. 7,189,269 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims a process for preparing a fuel composition comprising the step of blending a Fischer-Tropsch derived gas oil, an oxygenate, and a base fuel which may be a petroleum derived gas oil which appears to meet the limitations of independent method claim 1 which comprises the step of adding to a petroleum derived gas oil a volume amount of a Fischer-Tropsch derived gas oil. Appellants allow for the addition of oxygen-containing compounds to the fuel composition as set forth on page 8 of the specification.

Claims 1-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Suppes and Berlowitz et al, considered separately.

Suppes discloses a composition suitable as a compression-ignition fuel, i.e., a diesel fuel, which comprises from about 30 to about 95 mass % of a light synthetic crude or syncrude, preferably from Fischer-Tropsch synthesis, and from about 5 to about 70 mass % of a blending stock, wherein the blending stock has an average molecular weight less than the average molecular weight of the light syncrude. Sources of hydrocarbon blend stocks include products and intermediates of petroleum refineries and refined syncrude. Other sources include C₅ to C₉ alkanes, e.g., hexane, gasoline, biodiesel and naphtha. See column 8, lines 10-26. Suppes teaches that the blend results in an improvement in one or more desirable fuel properties including, but not limited to, pour point temperature, viscosity and emissions generated during

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combustion in a diesel engine. See column 4, line 66 to column 5, line 44. Although cetane number is not set forth, Suppes teaches that the cetane number of the composition is preferably greater than 35 and more preferably greater than 45. See column 5, lines 38-41. Suppes sets forth in Table 5 that the high cetane number of light syncrude allows blending with several different blend stocks while maintaining cetane numbers above 40. The examiner is of the position that independent claim 1 is drawn to a method ...comprising (the single step of) adding to a petroleum derived gas oil a volume amount of a Fischer-Tropsch derived gas oil. The claim language “of increasing the cetane number of a gas oil product based on a petroleum derived gas oil to a target cetane number Y” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further, the examiner maintains the position that appellants’ invention differs by the proviso in independent claim 1 that “wherein the volume amount of added Fischer-Tropsch derived gas oil is less than the volume amount which would be added if linear blending is assumed”. Although not set forth in Suppes, it is not clear how this proviso distinguishes over the prior art since the blending components and the amount of each component may be the same.

Berlowitz et al [“Berlowitz”] disclose a diesel fuel blended fuel composition which comprises an undercut conventional diesel fuel and a Fischer-Tropsch derived diesel fuel. Berlowitz teaches that the blend demonstrates better than expected emissions and a reduced

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sulfur content when used in a diesel engine. See column 2, lines 17-63. The Fischer-Tropsch derived diesel fuel is set forth in columns 3-4 and the examiner is of the position that this meets the limitations of the Fischer-Tropsch derived gas oil of the claims. The blended fuel composition was subjected to engine testing wherein the blended diesel fuel was compared to conventional petroleum diesel fuels. Berlowitz teaches that significantly lower emissions were produced from the diesel fuel blend when compared to two different conventional diesel fuels. See column 6, line 59 to column 7, line 40. The examiner is of the position that independent claim 1 is drawn to a method ...comprising (the single step of) adding to a petroleum derived gas oil a volume amount of a Fischer-Tropsch derived gas oil. The claim language “of increasing the cetane number of a gas oil product based on a petroleum derived gas oil to a target cetane number Y” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further, the examiner maintains the position that appellants’ invention differs by the proviso in independent claim 1 that “wherein the volume amount of added Fischer-Tropsch derived gas oil is less than the volume amount which would be added if linear blending is assumed”. Although not set forth in Berlowitz, it is not clear how this proviso distinguishes over the prior art since the blending components and the amount of each component may be the same.

(10) Response to Argument

In regard to the nonstatutory obviousness-type double patenting rejection, appellants argue that the claims are drawn towards a very specific method of increasing the cetane number of a gas oil product based on petroleum derived gas oil which is not taught in the cited prior art. This is not deemed to be persuasive because method claim 1 comprises the step of “adding to the petroleum derived gas oil a volume amount of a Fischer-Tropsch derived gas oil ..” which does not differ from claim 20 of the patent which is drawn towards a “process for the preparation of a fuel composition...comprising blending a Fischer-Tropsch derived gas oil (ii) and an oxygenate (iii) with a base fuel (i).”

In regard to the rejection under 35 U.S.C. 103(a) as being unpatentable over Suppes, appellants argue that in column 19, lines 58-59, Suppes teaches that the biodiesel mixtures showed an almost linear impact of concentration on cetane number, and that in column 19, lines 61-63, Suppes teaches that the biodiesel increased the cetane number. Appellants argue that there is no indication that the syncrude increased the cetane number, particularly non-linearly. This is not deemed to be persuasive because appellants are pointing to a specific example containing the effect of an additional component, namely ethanol, and the disclosure of Suppes is not so limited. Further, Suppes teaches in column 19, lines 41-45, that generally synthetic fuels display “impressively high cetane numbers, sufficiently high to allow blending with low cetane fuels to obtain a better combination of cetane number and pour point.” Thus the examiner maintains the position that Suppes meets the limitations of the above rejected claims drawn to a method comprising “adding to the petroleum derived gas oil a volume amount of a Fischer-Tropsch derived gas oil”. Although Suppes does not teach that an amount of Fischer-Tropsch

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derived gas oil to be added to the petroleum derived gas oil may be less than that which would be added to produce a composition having a target cetane number if linear blending was assumed, it has been held that obviousness is not rebutted by merely recognizing additional advantages or latent properties present in the prior art. Indeed, "Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention." *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA1979).

In regard to the rejection under 35 U.S.C. 103(a) as being unpatentable over Berlowitz, appellants argue that although cetane number is mentioned in column 2, line 41, there is no discussion of any relationship between the cetane number and the concentration of components. Appellants argue that Berlowitz does not teach their claimed invention which is a very specific method of increasing the cetane number of a gas oil product which involves adding less than a particular amount of Fischer-Tropsch derived gas oil. This is not deemed to be persuasive because the method of the claims includes the step of "adding to the petroleum derived gas oil a volume amount of a Fischer-Tropsch derived gas oil" which is clearly taught by Berlowitz as outlined above. As taught by appellants in the specification on page 1, it is known that petroleum derived gas oils have generally a lower cetane number than gas oils derived from a Fischer-Tropsch process. Blends of petroleum derived gas oils and Fischer-Tropsch derived gas oils in wide ranging amounts are known as evidenced by Berlowitz set forth above. Thus the examiner maintains the position that Berlowitz meets the limitations of the above rejected claims drawn to a method comprising "adding to the petroleum derived gas oil a volume amount of a Fischer-Tropsch derived gas oil". Although Berlowitz does not teach that an amount of

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Fischer-Tropsch derived gas oil to be added to the petroleum derived gas oil may be less than that which would be added to produce a composition having a target cetane number if linear blending was assumed, it has been held that obviousness is not rebutted by merely recognizing additional advantages or latent properties present in the prior art. Indeed, "Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention." *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA1979).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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